

Application No.: 10/067,832

Docket No.: 229752000701

**In the Drawings:**

Please delete sheets 1, 5 and 8.

**REMARKS**

The Examiner requested that the specification be amended to include the relevant priority information. In accordance with the Examiner's request, the specification has been amended to include this information.

The Examiner has objected to drawings sheets 1, 5 and 8 because the sequences placed in these sheets are recited in the following sheets. These sheets have been deleted. Accordingly, this objection should be withdrawn. Further, the Examiner has objected to Figures 1A and 1B as including sequences listed in the sequences listings. In a telephone conversation on September 14, 2006, the Examiner acknowledged that this objection is not applicable to this application because this application was filed prior to the applicable rules.

The Examiner has objected to the title as not being descriptive of the claimed invention. The title has been amended to be more descriptive. Accordingly, this objection should be withdrawn.

Claims 8 and 9 have been objected to for including not elected sequences. Claim 8 has been amended claim 9 has been amended to remove reference to SEQ ID NO: 1.

Claims 7-10 stand rejected under 35 USC 112, second paragraph, as being indefinite. Specifically, claim 7 and 10 have been rejected for reciting "a derivative, homologue, analogue or mimetic thereof." This phrase has been removed from these claims. Accordingly, this rejection should be withdrawn.

Claim 9 has been rejected as being indefinite for reciting low stringency without reciting what constitutes low stringency. Claim 9 has been amended to include the high stringency conditions provided at page 14, lines 14 to 17 of the specification.

The Examiner has rejected claims 8 and 9 for including the term "substantially." This term has been removed from claim 9 and claim 8 has been cancelled. Accordingly, this rejection should be withdrawn.

Claim 7-10 stand rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the written description requirement. Claim 7 has been amended to specify that the protein comprises "an amino acid sequence as set forth in SEQ ID NO:14 or an amino acid sequence having at least 90% similarity to all or part of SEQ ID NO:14." As acknowledged by the examiner, the protein of SEQ ID NO: 14 and the protein encoded by SEQ ID NO: 13 comply with the written description and enablement provisions of 35 USC 112, first paragraph.

Further, the written description requirement can be complied with by showing functional and/or descriptive information concerning the specie(s) in an application, e.g., a distinguishing identifying characteristic common among the members of a claimed genus (see Guidelines for Examination of Patent Applications Under the 35 USC 112, para. 1, "Written Description" Requirement - Federal Register: January 5, 2001 (Volume 66, No.4, pgs. 1099-1111)). For example, at the bottom of pg. 1105, the Guidelines state that, "(a)n adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention."

The applicants' disclosure more than adequately meets this burden. The presently claimed invention is directed to the applicants' discovery that SEQ ID NO: 14 is produced in larger amounts in the hypothalamus tissue of obese animals compared to lean animals. This single identifying feature of the claimed invention, i.e., over expression in hypothalamus tissue of obese animals is common among the subject matter now claimed. Thus, the applicants' disclosure clearly identifies a sufficient, relevant, identifying characteristic that would lead the skilled artisan to recognize that the applicants were indeed in possession of the presently claimed invention at the time this application was filed. Accordingly, this rejection should be withdrawn.

Claims 7-10 also stand rejected under 35 USC 112, first paragraph, for allegedly not being enabled. This rejection is respectfully traversed. As explained above, claim 7 has been amended to

specify that the protein comprises “an amino acid sequence as set forth in SEQ ID NO:14 or an amino acid sequence having at least 90% similarity to all or part of SEQ ID NO:14.”

The claims as amended are enabled by the specification. Specifically, the specification is replete with guidance as to how one of skill in the art would make modifications to the claimed protein (see for example page 16, line 9 through page 21, line 17). Further, it is respectfully submitted that one of skill in the art would consider the generation of modified proteins which demonstrate 90% similarity to SEQ ID NO: 14 using routine amino acid substitutions/modifications. Further, having made these modifications, one of skill in the art could use, based on the teachings of the specification, could ascertain if these modified proteins were expressed in higher amounts in the hypothalamus tissue of obese animals compared to lean animals. Accordingly, this rejection should be withdrawn.

Claims 7 and 10 stand rejected under 35 USC 102(b) as being anticipated by Wilding. As previously explained claim 7 has been amended to specify that the protein comprises “an amino acid sequence as set forth in SEQ ID NO:14 or an amino acid sequence having at least 90% similarity to all or part of SEQ ID NO:14.” In the Action, the Examiner acknowledges that Wilding does not disclose a protein as claimed. Accordingly, this rejection should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **229752000701**.

Dated: September 14, 2006

Respectfully submitted,

By 

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